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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,468	06/07/2001	Takaaki Hirai	107176-00006	6366

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/856,468

Applicant(s)

HIRAI ET AL.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1 and 3-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
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1700



NOTE

1. Applicants' proposed amendment to cancel claim 9, and incorporate its element "crystallinity in the range of from 1 to 8%" into amended claim 1, has been entered. However, the Examiner repeats (see Paper No. 0915, page 5) that Park clearly teaches that by incorporating greater than 15 wt% of the co-monomers, an amorphous polyester, rather than a crystalline polyester is obtained. As such, it is believed that a suitable small amount of the aforementioned co-monomers is either inherently disclosed by JP '590, or an obvious optimization to one skilled in the art to incorporate a small amount of co-monomers (e.g., less than 15%, as taught by Park), motivated by the desire to obtain a suitable low crystallinity (i.e., not fully amorphous) in the pre-expanded foam particles, as taught by JP '590. In the absence of unexpected results, it is believed that the prior rejection is still deemed proper. Finally, the Examiner notes that if continued prosecution, i.e., a CPA or RCE, is contemplated, the minor informalities of claims 15-18 being dependent upon cancelled claim 2 should be corrected.
2. Applicants' argument that the melt tension measurement conditions is supported in the original specification is persuasive. As such, the objection to the amended specification under 35 U.S.C. 132 is withdrawn.
3. Regarding to Applicants' traversal of the rejection of claims 6 and 16 (Remarks, page 5, bottom paragraph), it should be noted that although the specification was

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amended to add the melt tension measurement conditions, the conditions are still absent from the claims.

4. With respect to Applicants' remarks regarding a Declaration and Experimental Report submitted concurrently with the amendment (Remarks, page 7, 2nd and 3rd paragraphs), the Examiner notes that there was no such Declaration and Experimental Report to be found with the newly submitted amendment. Additionally, it should be noted that it is untimely to submit Declaration after Final.